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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/649,436	08/25/2000	Thomas D. Holt	004117.P006X	6870

7590 02/22/2010  
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EXAMINER
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ART UNIT	PAPER NUMBER
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2166

MAIL DATE	DELIVERY MODE
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02/22/2010

PAPER

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* THOMAS D. HOLT and LARRY STEPHEN BURKE

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Appeal 2008-005361  
Application 09/649,436<sup>1</sup>  
Technology Center 2100

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Decided: February 22, 2010

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Before ST. JOHN COURTENAY, III, THU A. DANG, and  
CAROLYN D. THOMAS, *Administrative Patent Judges*.

THOMAS, *Administrative Patent Judge*.

DECISION ON APPEAL

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<sup>1</sup> Application filed August 25, 2000. The real party in interest is Surfwax, Inc.

## I. STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134(a) from a final rejection of claims 1, 2, 6, and 10-46, which are all the claims remaining in the application, as claims 3-5 and 7-9 are cancelled. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm-in-part.

## A. INVENTION

Appellants invented a method for applying linguistics and syntax analysis to augment searching. (Spec. 2, ll. 18-19.)

## B. ILLUSTRATIVE CLAIMS

The appeal contains claims 1, 2, 6, and 10-46. Claims 1, 6, 10, 19, 22, 34, and 44 are independent claims. Claim 1 and 44 are illustrative:

1. A method for real-time distillation of a source document, comprising:
  - receiving search criteria from a client;
  - searching at least one source based on the search criteria;
  - determining search results responsive to said searching;
  - distilling a selected one of the search results in substantially real time relative to the time of selection, the selected search result having a first content and wherein the distillation comprises the step of extracting content from the first content in accordance with at least one data type criterion selected from a plurality of predefined data type criteria; and
  - creating a distilled version of the selected search result including the extracted content,
  - wherein the distilled version constitutes a data entity having a predefined format and that is distinct from the search result.

44. A method for searching, comprising:
- receiving search criteria;
  - searching at least one body of knowledge based on the search criteria;
  - providing a plurality of search results that are responsive to the searching, wherein at least one of the search results is a document comprised of text content;
  - selecting one of the text-content document search results;
- and
- at substantially the time of selection, distilling the selected document, wherein the step of distilling comprises the following steps:
    - extracting content from the selected document in accordance with a plurality of data type rules;
    - deriving a plurality of key points from the text content of the selected document, wherein key points are at least partially identified by locating text portions within the document that contain predefined verb types; and
    - generating a reduced content distilled document that contains at least a portion of the extracted content and at least one of the key points.

### C. REFERENCES

The references relied upon by the Examiner as evidence in rejecting the claims on appeal are as follows:

Rubinstein	US 5,913,215	Jun. 15, 1999
Lumsden	US 6,006,217	Dec. 21, 1999
Balasubramaniam	US 6,359,633 B1	Mar. 19, 2002

## D. REJECTIONS

The Examiner entered the following rejections which are before us for review:

- (1) Claims 44-46 are rejected under 35 U.S.C. § 102(b) as being anticipated by Rubinstein; and
- (2) Claims 1, 2, 6, and 10-43 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Lumsden in view of Balasubramaniam.

## II. FINDINGS OF FACT

The following findings of fact (FF) are supported by a preponderance of the evidence.

### *Specification*

1. In the Specification, a distilled format “is a reduced content version of a source document. For example, for a text document, distillation provides a condensed abstract of the document based on the language within the source document.” (Spec., 10:8-10.)

### *Rubinstein*

2. Rubinstein discloses that “[t]he document abstract pane 270 is used to present an abstract from a document identified based on the query expression constructed by the user. The identified document is a document meeting the logical criteria set forth in the query expression.” (Col. 7, ll. 55-59.)

3. Rubinstein discloses that “an abstract of the identified document is generated by first performing linguistic analysis on the document to identify concept sentences (i.e., sentences containing keyword phrases) and then combining the concept sentences.” (Col. 7, ll. 62-66.)

4. In Rubinstein, “[r]eferential analyzers, including Syntactica, perform paragraph by paragraph parsing of documents using dictionary definitions of words to identify grammatically and definitionally significant phrases (i.e., keyword phrases).” (Col. 8, ll. 35-38.)

*Lumsden*

5. Lumsden discloses a “method for providing enhanced search results for searches for documents on the Internet.” (Abst.)

6. In Lumsden, “the preparation includes modifying the search criteria matches as they appear in the document so that the matches will be visually distinctive to the user when the user views the document.” (Col. 6, ll. 59-62.)

7. Lumsden discloses that “the document is also modified to include code that causes user selection of one of the matching keywords in the document . . .” (Col. 6, l. 67 to col. 7, l. 4.)

*Balasubramaniam*

8. Balasubramaniam discloses “a method to generate a hyperlinked abstract from a markup language document by parsing the document to create a syntax tree, . . .” (Abst.).

9. In Balasubramaniam, the tree is summarized. (Col. 1, ll. 64-65.)

### III. PRINCIPLES OF LAW

In rejecting claims under 35 U.S.C. § 102, “[a] single prior art reference that discloses, either expressly or inherently, each limitation of a claim invalidates that claim by anticipation.” *Perricone v. Medicis Pharm. Corp.*, 432 F.3d 1368, 1375 (Fed. Cir. 2005), citing *Minn. Mining & Mfg.*

*Co. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559, 1565 (Fed. Cir. 1992).

Anticipation of a patent claim requires a finding that the claim at issue ‘reads on’ a prior art reference. In other words, if granting patent protection on the disputed claim would allow the patentee to exclude the public from practicing the prior art, then that claim is anticipated, regardless of whether it also covers subject matter not in the prior art.

*Atlas Powder Co. v. IRECO, Inc.*, 190 F.3d 1342, 1346 (Fed Cir. 1999) (internal citations omitted).

“What matters is the objective reach of the claim. If the claim extends to what is obvious, it is invalid under § 103.” *KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. 398, 419 (2007). To be nonobvious, an improvement must be “more than the predictable use of prior art elements according to their established functions.” *Id.* at 417.

#### IV. ANALYSIS

##### *Grouping of Claims*

In the Brief:

Appellants argue claims 44-46 as a group (App. Br. 9-18). For claims 45 and 46, Appellants repeat the same argument made for claim 44. We therefore treat claims 45 and 46 as standing or falling with claim 44.

Appellants argue claims 1, 2, 6, and 22-33 as a group (App. Br. 19-23; 26-28). For claims 2, 6, and 22-33, Appellants essentially repeat the same argument made for claim 1. We therefore treat claims 2, 6, and 22-33 as standing or falling with claim 1.

Appellants argue claims 10-21 as a group (App. Br. 23-26). For claims 11-21, Appellants essentially repeat the same argument made for

claim 10. We therefore treat claims 11-21 as standing or falling with claim 10.

Appellants argue claims 34-43 as a group (App. Br. 28-30). For claims 35-43, Appellants essentially repeat the same argument made for claim 34. We therefore treat claims 35-43 as standing or falling with claim 34. *See* 37 C.F.R. § 41.37(c)(1)(vii). *See also In re Young*, 927 F.2d 588, 590 (Fed. Cir. 1991).

### *The Anticipation Rejection*

#### *Claims 44-46*

We first consider the Examiner's rejection of claims 44-46 under 35 U.S.C. § 102(b) as being anticipated by Rubinstein.

Appellants contend that “[a]s is taught throughout the *Rubinstein* specification, the linguistic generation of ‘concept sentences’ and ‘keyword phrases’ is conducted for all of the documents prior to a search being conducted in the first instance.” (App. Br. 14.) Appellants further contend that “[n]owhere in that discussion is there any mention of utilizing ‘predefined verb types’ and a technique for identifying key points, as is specifically required by the claim.” (App. Br. 17.)

The Examiner found that Fig. 1 of Rubinstein discloses “step 140 recites ‘Linguistically analyze the identified document to generate an abstract’ corresponds to [the claimed *at substantially the time of the selection, distilling the selected search result*].” (Ans. 20.) The Examiner further found that “Rubinstein teaches at Col. 8 lines 35-40 the step of Linguistic Analysis by ‘perform[ing] paragraph by paragraph parsing of documents using dictionary definitions of words to identify grammatically and definitionally significant phrases (i.e., keyword phrases).’” (Ans. 21.)



Issue: Have Appellants shown that the Examiner erred in finding that Rubinstein discloses distilling the selected document at substantially the time of selection and locating text portions within the document that contain predefined verb types?

Appellants' Specification discloses that a "distilled document" is a reduced version of the source document, i.e., an abstract (FF 1). Similarly, Rubinstein discloses presenting an abstract of a document identified by a query (FF 2). However, Appellants essentially contend that Rubinstein's abstract is not distilled at substantially the time of selection of the document but rather before the database is ever searched by the user (App. Br. 12). We disagree.

For example, Rubinstein discloses that an abstract is presented to the user and that the abstract comes from a document identified based on the query expression constructed by the user (FF 2). Rubinstein further discloses that the abstract of the identified document is generated by performing linguistic analysis on the document to identify concept sentences (FF 3). Additionally, as shown in Fig. 1, steps 130-150 of Rubinstein, after the user constructs a query, one document is identified, linguistically analyzed to generate an abstract, and then the abstract is presented to the user. Thus, we find that the claimed "*at substantially the time of selection, distilling the selected document*" reads on Rubinstein's above noted features.<sup>2</sup>

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<sup>2</sup> We note that our reviewing court has adopted a broad construction for the term "substantial" as used in patent claims. The Court of Appeals for the

Appellants further contend that Rubinstein fails to use “predefined verb types” in identifying key points (App. Br. 17.) However, Rubinstein discloses parsing the document paragraph by paragraph to identify grammatically and definitionally significant phrases (FF 4). The ordinary and usual meaning of “grammatically” includes looking at classes of words, their inflections, and their functions and relations in the sentence. *Merriam-Webster’s Collegiate Dictionary*, p.531 (9<sup>th</sup> Ed. 1990). We find that Rubinstein’s grammatical analysis includes reviewing all classes of words, including verb type. Thus, the claimed “*locating text portions within the document that contain predefined verb types*” reads on Rubinstein’s grammatical and definitional analysis of phrases.

As to the other recited elements of claim 44, Appellants provide no argument to dispute that the Examiner has correctly shown where all these claimed elements appear in the prior art. Thus, we deem those arguments waived. *See* 37 C.F.R. § 41.37(c)(1)(vii) (2008).

Accordingly, Appellants have *not* persuaded us of error in the Examiner’s conclusion of anticipation for representative claim 44.

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Federal Circuit has reaffirmed that the term “substantial” implies “approximate.” *Wilson Sporting Goods Co. v. Hillerich & Bradsby Co.*, 442 F.3d 1322, 1329 (Fed. Cir. 2006). *See also Playtext Products, Inc. v. Procter & Gamble Co.*, 400 F.3d 901, 907 (Fed. Cir. 2005) (“The term ‘substantial’ is a meaningful modifier implying ‘approximate,’ rather than ‘perfect.’”), citing *Liquid Dynamics Corp. v. Vaughan Co., Inc.*, 355 F.3d 1361, 1368 (Fed. Cir. 2004). In *Wilson Sporting Goods*, the court determined that a claimed “insert having a *substantially* circular cross-section” did not need to be *perfectly* circular [emphasis added]. *Wilson Sporting Goods*, 442 F.3d at 1328-29. Similarly, in *Playtext Products*, the court determined that the claimed “*substantially* flattened surfaces” did not require a *perfectly* flat surface. *Playtext Products*, 400 F.3d at 907.

Therefore, we affirm the Examiner's § 102 rejection of independent claim 44 and of claims 45 and 46, which fall therewith.

*The Obviousness Rejection*

We now consider the Examiner's rejection of claims 1, 2, 6, and 10-43 under 35 U.S.C. § 103(a) as being unpatentable under Lumsden and Balasubramaniam.

*Claims 1, 2, 6, and 22-33*

Appellants contend that “the addition of material to the enhanced document, as taught by *Lumsden*, is contrary to the ‘distillation’ process recited in claim 1 where materials are extracted from a search result.” (App. Br. 20.)

Appellants further contend:

Thus, *Lumsden* purports to provide an enhanced user Web search experience by providing the user with information concerning documents accessible by way of the internet. This end is achieved through the creation and use of “enhanced” documents. In light of this teaching, it is not clear that the use of abstracts such as disclosed in *Balasubramaniam* would provide any additional benefit in terms of user experience.

(App. Br. 22.)

In addition, Appellants contend that “the Examiner has not established, nor even asserted, that *Balasubramaniam* teaches or suggests the limitation actually recited in claim 1.” (*Id.*)

The Examiner found that

*Lumsden* teaches at Fig. 5 that the “enhanced document” can be created from a search result by clicking on link 60. *Lumsden*'s enhanced document is therefore “a reduced content version of a given result” because it “allows a user to quickly review” and

thereby “determine whether the corresponding full content version is of interest.”

(Ans. 23.) The Examiner concludes that “‘reduce content version’ does not necessar[ily] mean ‘reduce size version’ or ‘reduce length version’ of the document.” (Ans. 24.) The Examiner further found that “Balasubramaniam teaches a method for automatically creating an abstract, which is a summarized version of the document and can be transmitted to a user at a much faster pa[ce].” (*Id.*)

Issue: Have Appellants shown that the Examiner erred in finding that the combination of Lumsden and Balasubramaniam discloses that distillation comprises the step of extracting content from the first content and creating a distilled version of the selected search result including the extracted content?

As noted *supra*, Appellants define a “distilled version” of a document as a reduced content version of a source document (FF 1). The Examiner found that Lumsden’s enhanced document is a reduced content version of a given result (Ans. 23). We disagree.

For example, Lumsden discloses that the enhanced version modifies the search matches in the document so that the matches are visually distinctive to the user (FF 5-6), and then adds code to the document which allows the user to select a matching keyword (FF 7). In other words, Lumsden’s enhanced version is merely a highlighted expanded version of the original document. In contrast, claim 1 requires a reduced version (i.e., a smaller version) of the source document to be generated. Thus, we find that

the claimed “distilled version” is distinguishable from Lumsden’s enhanced version.

The Examiner also found that Balasubramaniam discloses automatically creating abstracts for documents (Ans. 24). While Balasubramaniam’s abstract can be seen as a reduced version of a source document, the Examiner has not shown that such an abstract is created from extracting content from the source content, as required by claim 1.

For example, Balasubramaniam discloses that the abstracts are created by parsing the document to create a syntax tree (FF 8). Then, the tree is summarized (FF 9). However, the Examiner has not shown that Balasubramaniam or Lumsden creates the abstracts by extracting content from the source document in accordance with at least one data type criterion selected from a plurality of predefined data type criteria, as required by claim 1.

Furthermore, the Examiner concluded that

[b]ecause users of Lumsden’s system are only interest[ed] in portions of document containing the matching keywords, it would have been obvious to one of ordinary skill in the art to modify Lumsden’s system as suggested by Balasubramaniam to create and send a summarized version of the document for faster transmission.

(Ans. 24-25.) We disagree.

For instance, Lumsden’s user gets an enhanced version of the document. As such, we find that going from an enhanced version to an smaller abstract version would defeat the purpose of Lumsden’s invention. Contrary to the Examiner’s findings, Lumsden’s user are not “only interested in portions of the documents” but rather are interested in being

able to efficiently navigate to interested portions of the document using graphically highlighted keywords. Thus, we find the Examiner's articulated reason for modifying Lumsden to only send abstracts deficient. Therefore, we cannot sustain the rejection of representative claim 1.

Thus, Appellants have persuaded us of error in the Examiner's conclusion of obviousness for representative claim 1. Therefore, we reverse the Examiner's § 103 rejection of independent claim 1 and of claims 2, 6, and 22-33, which stand therewith.

#### *Claims 10-21*

Appellants contend that "the lengthy passage cited by the Examiner concerns creation of an abstract, and has nothing to do with presentation, to a user, of a mid-menu that corresponds to a result object." (App. Br. 25.)

Appellants further contend that

the "abstractor" cited by the Examiner is employed to create the abstract . . . so the operation of the "abstractor" necessarily commences before the "abstract" has been created. On the other hand, the "mid-menu" recited in claim 10 is not created until after the result object, alleged by the Examiner to correspond to the "abstract," has already been produced.  
(*Id.*)

The Examiner found that "Balasubarmaniam teaches the step of creating a classified tree (i.e., 'mid-menu') that corresponds to the document to form an abstract, and displaying the abstract to the user, and therefore anticipates the claimed limitations." (Ans. 26-27.)

Issue: Have Appellants shown that the Examiner erred in finding that Balasubarmaniam discloses creating a mid-menu that corresponds to the

result object, the mid-menu comprising a plurality of menu options and displaying the mid-menu?

The Examiner found that Balasubarmaniam's classified tree corresponds to the claimed mid-menu (Ans. 26-27). However, we initially note that the Examiner has failed to show that Balasubarmaniam's classified tree (i.e., alleged mid-menu) is displayed, as required by claim 10. Instead, the Examiner merely states that the "abstract" *formed by* the classified tree is displayed to the user (*id.*). Thus, even if we find that the claimed "mid-menu" reads on Balasubarmaniam's classified tree (which we have not), the Examiner has failed to establish that such a tree is displayed.

Furthermore, as argued by Appellants, the mid-menu is created to correspond to the result object, which necessarily dictates that the creation of mid-menu *follows* the creation of the result object. (App. Br. 25.) We agree. For at least this reason, the claimed "mid-menu" cannot read upon Balasubarmaniam's classified tree which *precedes* the creation of the abstract.

Thus, Appellants have persuaded us of error in the Examiner's conclusion of obviousness for representative claim 10. Therefore, we reverse the Examiner's § 103 rejection of independent claim 10 and of claims 11-21, which stand therewith.

#### *Claims 34-43*

In essence, for claims 34-43, Appellants present the same arguments as presented *supra* regarding claims 1 and 10, which we have found persuasive.

Thus, Appellants have persuaded us of error in the Examiner's conclusion of obviousness for representative claim 34. Therefore, we reverse the Examiner's § 103 rejection of independent claim 34 and of claims 35-43, which stand therewith.

## V. CONCLUSIONS

We conclude that Appellants have *not* shown that the Examiner erred in rejecting claims 44-46 under 35 U.S.C. § 102(b).

We conclude that Appellants have shown that the Examiner erred in rejecting claims 1, 2, 6, and 10-43 under 35 U.S.C. § 103(a).

## VI. DECISION

In view of the foregoing discussion, we affirm the Examiner's rejection of claims 44-46, but reverse the Examiner's rejection of claims 1, 2, 6, and 10-43.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2009).

## AFFIRMED-IN-PART

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